III. REMARKS

Claims 1-20 are pending in this application. By this Amendment, claim 1 has been amended. This amendment is being made to facilitate an early allowance of the claimed subject matter. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 5, 13-14, 16-17 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant gratefully appreciates this indication.

In the Office Action, claims 1-4 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Molla *et al.* (U.S. Patent No. 6,625,560), hereafter "Molla," in view of Mitten *et al.* (U.S. Patent No. 6,564,349), hereafter "Mitten," and Variyam *et al.* (U.S. Patent No. 6,661,266), hereafter "Variyam"; claims 6-10 and 12 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Molla, in view of Mitten, Variyam and Fang (U.S. Patent No. 6,236,697); claim 11 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Molla, in view of Mitten, Variyam, Fang and Kuo (U.S. Patent No. 5,248,905); and claims 15 and 18 are rejected under the same reasons as claims 1 and 8. Applicant respectfully submits that the claimed subject matter is allowable for the reasons stated below.

Applicant submits that the suggested combination of the cited prior references does not teach or suggest each and every feature of the claimed invention. For example, with regard to independent claim 1, the claimed invention includes, *inter alia*, "a built-in-self-test (BIST) device ... for providing a clock signal with varied offset for jitter testing of the network data signal[.]" Applicant submits that the suggested combination of the cited prior art does not disclose or suggest, *inter alia*, this feature. Molla discloses that "[i]f immunity to phase jitter is to be tested, the section **10A** test equipment operates to introduce a specified amount of phase jitter into the clock used to produce the clock information." (Col. 1, lines 30-33). However, in Molla, the jitter is not produced by varying an offset of the clock signal. Rather, Molla introduces a specified amount of phase jitter into the clock. That is, the jitter in Molla is not provided with multiple variations of the clock signal offset. In contrast, the claimed invention provides a clock signal with a varied offset for jitter testing. For example, "the present invention provides such jitter by allowing an offset of the clock signal to be varied between early timing 100, normal timing 102 and late timing 104." (Specification of the claimed invention at page 10). In view of the foregoing, Molla does not disclose or suggest, *inter alia*, "providing a clock signal with a varied offset for jitter testing of the network data signal[.]" (Claim 1 of the claimed invention). Mitten and Variyam do not overcome, *inter alia*, this deficiency of Molla.

With regard to independent claim 8, the claimed invention includes, *inter alia*, "a built-in-self-test (BIST) device for ... varying a pulse width of the network data signal[.]" As the Office admits, Molla, Mitten and Variyam do not disclose or suggest this feature. (Office Action at page 6). Contrary to the Office's assertion, however, Applicant submits that Fang does not overcome, *inter alia*, this deficiency of Molla, Mitten and Variyam. Fang discloses "[recovering]

a clock from an input signal that is received at a first frequency or at a second frequency, in response to a mode signal that indicates whether the first or second frequency is received." (Col. 2, lines 19-21). Fang generates a pulse, based on which a clock signal is recovered from an input data. In Fang, "[t]he width of the pulse is selected as a function of the frequency of the input data." (Col. 5, lines 29-31). However, Fang does not disclose or suggest, *inter alia*, varying a pulse width of the input data. Rather, Fang recovers a clock signal using a pulse, whose width is a function of the input data. That is, Fang only uses the input data as a reference and does not vary any characteristic of the input data. In contrast, the claimed invention includes, *inter alia*, "a built-in-self-test (BIST) device for varying a pulse width of the network data signal[.]" (Claim 8). In addition, attempting to recover a clock signal, Fang does not disclose or suggest varying a pulse width. Instead, Fang strives to obtain a pulse width exactly the same as the clock signal. In view of the foregoing, the suggested combination of the cited prior art does not disclose or suggest each and every claimed feature.

Moreover, Applicant submits that there is no suggestion or motivation to combine the cited references. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." *Karsten Mfg. Corp. v. Cleveland Gulf Co.* 242 F. 3d 1376, 1385 (Fed. Cir. 2001). In this case, there is no such suggestion, motivation or teaching in the prior art.

For example, Fang is related to recovering a clock signal from an input signal. In Fang, the generation of a pulse is used to produce a clock signal. In contrast, Variyam is related to measuring errors in a periodic signal. As such, Applicant does not understand why Variyam is motivated to

adopt the teaching of Fang, i.e., generating a pulse to produce a clock signal, in the measuring of errors in a periodic signal. On the other hand, Applicant also does not understand why Fang would adopt the teaching of Variyam, including use of BIST, in the recovering of clock signal, because Fang needs to use the input data as untouched to generate the clock signal. That is, adopting of a BIST of Variyam will make Fang unsatisfactory for its intended purpose. The Office asserts that the motivation to combine comes from "the benefit of versatility." (Office Action at page 7, citing Fang at col. 1, lines 43-46.) Applicant does not understand how the "versatility" comes from. The cited portion of Fang does not provide any hints of such "versatility." Applicant submits that the Office obtains a suggestion and motivation to combine only from the hindsight teachings of the current invention, which is not warranted in a Section 103 rejection. In view of the foregoing, there is no suggestion, motivation or teaching that would have led a person of ordinary skill in the art to combine Molla, Mitten, Variyam and Fang to produce "a built-in-self-test (BIST) device for ... varying a pulse width of the network data signal[.]" (Claim 8 of the claimed invention).

The above arguments also apply to claims 15 and 18, as claims 15 and 18 include "varying a pulse width of the network data signal" and "varying an offset of a clock signal embedded within the network data signal[.]" (Claim 15, similarly claimed in claim 18).

The dependent claims are believed allowable for the same reasons stated above, as well as for their own additional features

IV. CONCLUSION

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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Ronald A. D'Alessandro
Reg. No.: 42,456

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)